



UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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Mailed: MAY 15 2002

Paper Number \_\_\_\_\_

In re application of  
Randell L. Mills  
Serial No. 09/009,294  
Filed: January 20, 1998  
For: HYDRIDE COMPOUNDS

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: DECISION ON  
: PETITION  
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This is a decision on the REQUEST FOR RECONSIDERATION OF DECISION ON PETITION, filed November 19, 2001, requesting reconsideration of the of the DECISION ON PETITION of Paper #37. This REQUEST FOR RECONSIDERATION OF DECISION ON PETITION alleges that the DECISION ON PETITION of Paper #37 fails to respond to the specific grounds on which Applicant's Petition was based and merely maintains that the Final Rejection is based on the same statutory grounds and the same reasoning as the first Office action. The DECISION ON PETITION of Paper #37 outlined the following two reasons for denial:

(1) No new ground of rejection was applied by the examiner in the Final Office action. The 35 USC 101 and 35 USC 112, first paragraph rejections were the same as those in the previous Non-Final Office action (in fact the examiner refers back to the previous Office action for the reasoning in making the rejections). The arguments put forth by the examiner do not constitute a new ground of rejection in that they merely respond to arguments presented by applicant and do not change the basis for the rejections (i.e. the rejections are still based on lack of utility and enablement as set forth in the previous office action).

(2) A clear issue was in fact developed between the examiner and applicant in the Final Office action. In the Non-Final action mailed September 1, 2000, the only grounds of rejection were the 35 USC 101 and 35 USC 112, first paragraph rejections mentioned above. The examiner set forth reasoning to support these rejections. Applicant then replied to the rejections and the positions of the examiner. The rejections were maintained in the Final Office action and the examiner answered the arguments filed by applicant relating to the issue of whether the claims were lacking in utility and enablement. The issues in the present application are clear - whether the claims lack utility and are enabled to one of ordinary skill in the art.

## DECISION

Petitioner's request for reconsideration can not be granted for the following two reasons:

(1) As detailed in the PETITION DECISION of Paper #37, no new ground of rejection was applied by the examiner in the Final Office action. The 35 USC 101 and 35 USC 112, first paragraph rejections were simply repeated as set forth in the previous Non-Final Office action of September 1, 2000. Specifically, both rejections simply state that the rejections are being maintained for "the reasons of record" without any additional stated basis for the rejections.

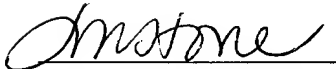
(2) While the statement in the Petition that the examiner incorporated additional reasoning in the Final rejection of the claims is correct, this was done solely to answer the substance of the applicant's traversal of the response dated March 1, 2001 to the Non-final Office action. As set forth in MPEP 707.07(f):

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

After an Office action, the reply (in addition to making amendments, etc.) may frequently include arguments and affidavits to the effect that the prior art cited by the examiner does not teach how to obtain or does not inherently yield one or more advantages (new or improved results, functions or effects), which advantages are urged to warrant issue of a patent on the allegedly novel subject matter claimed. If it is the examiner's considered opinion that the asserted advantages are not sufficient to overcome the rejection(s) of record, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Patent Appeals and Interferences will also be advised.

Thus, the additional reasoning provided by the examiner in the Final Office action was in full compliance with the procedures detailed in MPEP 707.07(f).

Accordingly, this REQUEST FOR RECONSIDERATION is **DENIED**.



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Paper Number 37

In re application of  
Randell L. Mills.

Serial No. 09/009,294

Filed: January 20, 1998

For: HYDRIDE COMPOUNDS

DECISION ON  
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed July 3, 2001.

On September 1, 2000, a non-final office action was mailed to applicant (paper no. 27). The office action contained a rejection of all the claims under 35 USC 101 as lacking utility and 35 USC 112, first paragraph as lacking enablement.

A reply to the office action was filed by Applicant on March 1, 2001. In the reply, no amendments were made to the claims. Applicant presented arguments in an attempt to overcome the aforementioned rejections. Additionally, a declaration under Rule 132 was filed on June 22, 2001.

On July 3, 2001 a final office action was mailed (paper no. 34). All of the previous grounds of rejection were maintained.

Petitioner has argued that the finality of the last office action is improper. Petitioner argues that the finality is premature due to the introduction of new grounds of rejection that were neither necessitated by amendment of the claims, nor based on information submitted in an information disclosure statement. Additionally, it is argued that a clear issue between applicant and examiner has not been developed.

## DECISION

The non-final office action mailed September 1 2000 contained rejections over claims 1-299 under 35 USC 101 and 35 USC 112, first paragraph. The office action presented arguments as to why the claims lack utility and enablement under the appropriate statute. Applicant's response to this office action, filed March 1, 2001 attempted to rebut the positions set forth in the September 1, 2000 office action. In the final office action mailed July 3, 2001, the examiner maintained the previous grounds of rejection of claims 1-299 and specifically referred back to non-final Office action for the reasoning behind the rejections (see final office action, page 2, lines 2 and 3). In addition, the examiner responded to Applicant's arguments in a separate section (see final office action - Attachment). In the attachment, the examiner addressed the arguments set forth by Applicant in the response filed March 1, 2001 and the Rule 132 declaration. As to the first issue of premature finality, the MPEP states the following:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)

In the instant case, no new ground of rejection was applied by the examiner in the final office action. The 35 USC 101 and 112, first paragraph rejections were the same as those in the previous non-final action (in fact the examiner refers back to the previous office action for the reasoning in making the rejections). The arguments put forth by the examiner do not constitute a new ground of rejection in that they merely respond to arguments presented by applicant and do not change the basis for the rejections (i.e. the rejections are still based on lack of novelty and enablement as set forth in the previous office action).

As to the second issue of premature finality, the MPEP states the following:

Before final rejection is in order a clear issue should be developed between the examiner and applicant.

In the present case, a clear issue has in fact been developed between the examiner and applicant. In the non-final action mailed September 1, 2000, the only grounds of rejection were the 35 USC 101 and 35 USC 112, first paragraph rejections mentioned above. The examiner set forth reasoning to support these rejections. Applicant then replied to the rejections and the positions of the examiner. The rejections were maintained in the final office action and the examiner answered the arguments filed by applicant relating to the issue of whether the claims were lacking in utility and enablement. The issues in the present application are clear - whether the claims lack utility and are enabled to one of ordinary skill in the art.

Accordingly, the examiner properly made the July 3, 2001 Office action final.

The Petition is **DENIED**.



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